

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JULY 29, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Information Store, Inc.

Serial No. 75/055,756

Michael J. Bevilacqua and Barbara A. Barakat of Hale and
Dorr for applicant.

Kathleen de Jonge, Trademark Examining Attorney, Law Office
103 (Michael Szoke, Managing Attorney).

Before Quinn, Hohein and Walters, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

The Information Store, Inc. has filed a trademark
application to register the mark THE INFORMATION STORE for
the following services¹:

- Data management and data outsourcing services provided to gas, oil and other natural resource exploration and development companies, namely, processing data generated by others, computerized data base management of data generated by others and consulting services rendered in connection with the outsourcing, namely, business consultation, in International Class 35;

¹ Serial No. 75/055,756, filed February 8, 1996, based on an allegation of a bona fide intention to use the mark in commerce.

- Data management and data outsourcing services provided to gas, oil and other natural resource exploration and development companies, namely, electronic storage of data generated by others, in International Class 39; and
- Computer consulting services rendered in connection with data management to gas, oil and other natural resource exploration and development companies, namely providing advice regarding storing, organizing, preserving, managing, and providing access to data generated by others related to geographical areas, in International Class 42.

The application includes a disclaimer of INFORMATION apart from the mark as a whole.

The Trademark Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark THE INFORMATION STORE, previously registered for "document retrieval services,"² that, if used in connection with applicant's services, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See, In re E. I. du Pont de Nemours and*

² Registration No. 1,399,896, issued July 1, 1986, to Information Store Inc. (unrelated to applicant in this case), in International Class 42. [Sections 8 and 15 affidavits accepted and acknowledged, respectively.]

Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In the analysis of likelihood of confusion in this case, two key considerations are the similarities between the marks and the similarities between the services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Considering, first, the marks, it is clear, and applicant does not dispute, that applicant's mark and the registered mark are identical in appearance, sound, connotation and commercial impression.

Turning our consideration to the services, we note that, in deciding cases such as this, we are required to determine the issue of likelihood of confusion on the basis of the goods or services as set forth in the application and the cited registration, respectively. *See In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). It is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be seen by the same people under circumstances which could give rise, because of the marks used in connection with them, to a mistaken belief that they originate from or are in some way

associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein. We note, further, that "[i]f the marks are the same or almost so, it is only necessary that there be a viable relationship between the goods or services in order to support a holding of likelihood of confusion." *In re Concordia International Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983).

Based on the recitation of services of record in the application and the services recited in the cited registration, we agree with the Examining Attorney that applicant's and registrant's services are closely related, if not overlapping. The services applicant intends to provide under the mark involve the management of data for others in the indicated field and include storage of data for others and access to that data and to third parties' data. Registrant's services are very broadly identified as "document retrieval services." Contrary to applicant's contentions, this broad language is not limited to locating and copying documents. Rather, registrant's services, considered broadly, clearly encompass the data management and data outsourcing services specified by applicant, which necessarily would include the retrieval of documents, albeit electronically.

In view of the identical commercial impressions of applicant's mark, THE INFORMATION STORE, and registrant's mark, THE INFORMATION STORE, their contemporaneous use in connection with the closely related and/or overlapping services involved in this case would be likely to cause confusion as to the source or sponsorship of such services.

We reach this conclusion notwithstanding the fact that applicant's services will be expensive and offered to knowledgeable professionals in "gas, oil and other natural resource exploration and development companies." We note that registrant's identified services are not limited to a particular field. Therefore, we must presume that registrant's services are offered in all of the normal channels of trade to all of the usual purchasers for such services. *See Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). It is reasonable to assume that registrant's purchasers include "gas, oil and other natural resource exploration and development companies." Further, even knowledgeable business purchasers are not immune from confusion when the marks are identical and the identified services are closely related and/or overlapping and, thus, may emanate from the same source. *See, In re General Electric Company*, 180 USPQ 542 (TTAB 1973).

Finally, it is well established that one who adopts a mark similar to the mark of another for the same or closely related goods or services does so at his own peril, and any doubt as to likelihood of confusion must be resolved against the newcomer and in favor of the prior user or registrant. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed Cir. 1988); and *W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308 (TTAB 1976).

Decision: The refusal under Section 2(d) of the Act is affirmed.

T. J. Quinn

G. D. Hohein

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board